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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/812,883	03/31/2004	Michael A. Porzio	249289US40	4571

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EXAMINER	
PADEN, CAROLYN A	
ART UNIT	PAPER NUMBER
1761	

NOTIFICATION DATE	DELIVERY MODE
06/28/2007	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No.	Applicant(s)	
	10/812,883	PORZIO ET AL.	
	Examiner	Art Unit	
	Carolyn A. Paden	1761	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *27 April 2007*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-26* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-26* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 1-4 and 9-26 are provisionally rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 4-9, 11, 12 & 17-39 of copending Application No. 10/864,631. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the prior application appear to contain the same components of compositions and process of c and d of the present application. Given the fact that there are

more components in the prior application, one of ordinary skill in the art would expect the components to have more than one glass transition temperatures.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

Claims 1-4 and 9-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-33 of U.S. Patent No. 6,652,895. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the prior application appear to contain the same components of compositions and process of c and d of the present application. In this case more than one maltodextrin and carbohydrate polymer are

contemplated in the claims. Given the fact that there are more components in the prior application, one of ordinary skill in the art would expect the components to have more than one glass transition temperatures.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

Claims 1-4 and 9-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-28 of U.S. Patent No. 6,790,453. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims in the prior application appear to contain the same components of compositions and process of c and d of the present application. In this case at least two food polymers are contemplated in the claims. Given the fact that there are at least two components in the prior application, one of

ordinary skill in the art would expect the components to have more than one glass transition temperatures.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-4 and 9-26 are rejected under 35 U.S.C. 103(a) as being obvious over Porzio (6,652,895).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This

rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Compositions c and d of the present claims are very similar to the compositions of the Porzio patent. Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a

or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

Claims 1-4 and 9-26 are rejected under 35 U.S.C. 103(a) as being obvious over Porzio (6,416,799).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a

terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

The claims in the prior application appear to contain the same components of compositions and process of c and d of the present application. In this case at least two food polymers are contemplated in the claims. Each of the food polymers would have been expected to have their own glass transition temperatures.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

Claims 1-4 and 9-26 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-21 of U.S. Patent No. 6,416,799. Although the conflicting claims are not

identical, they are not patentably distinct from each other because the claims in the prior application appear to contain the same components of compositions and process of c and d of the present application. In this case at least two food polymers are contemplated in the claims. Each of the food polymers would have been anticipated to have their own glass transition temperatures.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

Claims 1-4 and 9-26 are rejected under 35 U.S.C. 103(a) as being obvious over Porzio (6,187,351).

The applied reference has a common inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing

under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). This rejection might also be overcome by showing that the reference is disqualified under 35 U.S.C. 103(c) as prior art in a rejection under 35 U.S.C. 103(a). See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Claims 1-26 rejected under 35 U.S.C. 103(a) as being obvious over Porzio (5,897,897) or (5,603,971) for reasons of record.

Porzio discloses an encapsulation composition and process. The claims in the prior patent appear to contain the same components of compositions and process of b of the present application. In this case at least two food polymers are contemplated in the claims. Each of the food

polymers would have been anticipated to have their own glass transition temperatures. N-octenylsuccinic anhydride modified starch appears to be the same starch as sodium octenyl succinate modified starch identified in the patent at column 5, lines 46-48 and in claims 25-28 and the source of the starch appears to be the same in the application at page 20, lines 1-7 as in the patent (column 4, lines 18-22). The claims appear to differ from the prior patent in the recitation of the use of more than one octenylsuccinic anhydride modified starch. But where more than one source of the modified starch is available from a different company, it would have been obvious to use one or more sources of the modified starch according the availability of the starch and the particular properties desired in the encapsulated composition.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. No unobvious difference is seen from the selection on an extrudate gum instead of an gum generally or extract gum.

Claims 1-4 and 9-26 are rejected under 35 U.S.C. 102(b) as being anticipated by Levine (5,009,900) and (5,087,461) and see Figure 1 and Summary.

Applicant urges that the references are unrelated to the present process or products. This has been considered but is not persuasive. Claim 1 provides for a composition comprising an encapsulate and a glass matrix. The glassy matrix may be selected from a or b or c or d. Claims 1, 16 or 23 do not require n-octenyl anhydride-modified starches that are either dextrinized or hydrolyzed. The claims do not require gums as a food polymer source.

No claim is allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a

first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Keith Hendricks, can be reached on (571) 272-1401 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private

PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carolyn Paden 6-23-07
CAROLYN PADEN
PRIMARY EXAMINER 1761